

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

4/30/02

Hearing:
January 5, 2002

Paper No. 15
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Gregory Speirs

Serial Nos. 75/646,864; 75/519,553; 75/523,613; 75/538,701;
75/566,226; 75/568,149 and 75/575,759.

Steven M. Hoffberg of Milde, Hoffberg & Macklin LLP for
Gregory Speirs.

Daniel F. Capshaw, Trademark Examining Attorney, Law Office
109 (Ronald R. Sussman, Managing Attorney).

Before Cissel, Walters and Bottorff, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

This appeal involves seven applications, all to
register marks on the Principal Register, and all of these
applications were filed by Gregory Speirs during 1998 and

1999. The first application¹ is for the mark shown below:

This is the only application in the group which is based on a claim of use. The goods listed in this application are as follows "t-shirts, baseball caps, boxer shorts, neckties, baseball jackets, tank tops, sneakers, denim shirts, dress shirts, golf shirts, gloves, fleece pullover jackets, sweaters, warm-up suits, shorts, socks, headbands, sweatshirts, hats, berets, scarves, polo shirts, fleece hats and caps," in Class 25.

The other applications involved in this appeal were all filed under Section 1(b) of the Lanham Act based on applicant's assertions that he possessed a bona fide intention to use the marks in commerce. The marks in these six applications are shown below.

¹ SN. 75/646,864, filed on February 27, 1999, claiming use in commerce since December 20, 1996.

LITHUANIAN SLAM DUNKING SKELETON

This is the only mark consisting of words only. The goods listed in this application² are "t-shirts, baseball caps, boxer shorts, neckties, baseball jackets, tank tops, sneakers, denim shirts, dress shirts, golf shirts, gloves, fleece jackets (pullovers), sweaters, warm-up suits, shorts, socks, headbands, sweatshirts, hats, berets, scarves, polo shirts," in Class 25.

² SN. 75/519,553, filed on July 15, 1998.

This mark is the subject of two applications.³ The goods listed in these applications are, respectively, are "t-shirts, baseball caps, neckties, baseball jackets, boxer shorts, tank tops, sneakers, denim shorts, dress shirts, golf shirts, gloves, fleece jackets (pullovers), sweaters, warm-up suits, shorts, socks, headbands, sweatshirts, hats, berets, scarves, polo shirts," in Class 25; and "action figures, porcelain figurines, dolls, board games, computer software games, toy chests, plush toys, action board games, action figure accessories, toy key chains, activity sets and playsets, video games, electronic arcade games, bicycles, flying toys, toy models, collectible toy models, kites, flying disk toys, card games, sport bottles, sport pack sacks, sport back packs, hand held battery operated toys, action flip card games, trivia games, resin based figurines, toy diaramas, arcade games with mechanical moving parts, toy balls, costume toys and masks, playing cards, toy vehicles, electronic games, balls for recreational use, toy model sets, art and crafts toy sets, toy model building sets, collectible figurines, golf balls, golf tees, boomerang flying toys, basketballs, basketball backboards, bean bag dolls, bean bag toys," in Class 28.

³ SNs 75/523,613 and 75/538,701, filed on July 22, 1998 and August 13, 1998, respectively.

The goods in the application⁴ to register this mark are stated as "trading cards, collectible cards, postcards, posters, comic books, stickers, decals, notebooks, diaries, bookmarks, pens, pencils, storybooks for children and adults, coloring books, children's activity books, printing blocks, rubber stamps, wrapping paper, appointment books, adventure story magazines, calendars, postcard books, playing cards, folders for papers, stencils, children's books, greeting cards, book covers, magic markers, acrylic paint sets, watercolor paint sets, learn-to-paint sets, paint by numbers sets, coloring sets, milk caps, puzzles," in Class 16.

⁴ SN. 75/566,226, filed on October 6, 1998.

In the application to register this mark⁵, the goods are identified as "t-shirts, baseball caps, boxer shorts, neckties, baseball jackets, tank tops, sneakers, denim shirts, dress shirts, golf shirts, gloves, fleece pullover jackets, sweaters, warm-up suits, shorts, socks, headbands, sweatshirts, hats, berets, scarves, polo shirts, fleece hats and caps," in Class 25.

⁵ SN. 75/568,149, filed on October 10, 1998.

In the application to register this mark⁶, the goods are identified as "t-shirts, baseball caps, boxer shorts, neckties, baseball jackets, tank tops, sneakers, denim shirts, dress shirts, golf shirts, gloves, fleece pullover jackets, sweaters, warm-up suits, shorts, socks, headbands, sweatshirts, hats, berets, scarves, polo shirts, fleece hats and caps," in Class 25.

Each of these seven applications has been refused registration under Section 2(a) of the Lanham Act on the ground that the mark falsely suggests a connection with the Lithuanian National Olympic Committee.⁷ When the refusals

⁶ SN. 75/575,759, filed October 22, 1998.

⁷ Originally, the Examining Attorney took the position that the marks falsely suggest connections with the Lithuanian National Basketball Team, but he subsequently issued an Office Action "revising the party" (brief, p. 2) with which he contends the marks falsely suggest connections.

to register became final, applicant timely filed notices of appeal in each of the cases. In each case, briefs were filed by both applicant⁸ and the Examining Attorney. Both applicant and the Examining Attorney presented arguments as to all seven applications at the oral hearing conducted before the Board on January 15, 2002.

Because the issue is essentially the same in each of these applications, and the facts are similar, we have considered the appeals together and issue a single opinion.

Based on careful consideration of the record, the arguments of applicant and the Examining Attorney and the relevant law, we hold that the refusals to register must be reversed in each application.

Although applicant and the Examining Attorney disagree as to the legal conclusion we should draw from the facts surrounding these cases, there is no apparent disagreement as to the facts themselves. A brief history of these marks, from the evidence of record, is necessary to understand the issue on appeal.

In 1992, Not Fade Away Graphics, Inc. was a company that provided merchandising services for the Grateful Dead rock and roll band. Not Fade Away Graphics, Inc. was a

⁸ The new evidence submitted by applicant with his appeal brief was properly objected to by the Examining Attorney because its

licensee of the Grateful Dead, and produced tie-dyed apparel bearing Grateful Dead logos. Applicant, Gregory Speirs, was involved in both the design and production of merchandise with silk-screen graphics for Not Fade Away Graphics, Inc.. Although he was a regular employee with regard to his responsibilities for production, in regard to his artistic design services he was an independent contractor. By agreement with his employer, he retained full ownership of the artwork he created.

According to applicant, before the 1992 Summer Olympics, the Grateful Dead band had decided to help the 1992 Olympic basketball team from Lithuania, which was apparently hard-pressed for financial support. Among other things, the band used its existing relationship with Not Fade Away Graphics, Inc. to have tie-dyed warm-up suits with custom graphics designed and manufactured for use by the team. The record does not show that the team issued a specific request or commissioned this design, but rather, that the band asked for it.

The president of Not Fade Away Graphics asked applicant to create artwork for this project. The graphics applicant developed employed skeleton themes in which he

submission did not comply with Trademark Rule 2.142(d). Accordingly, the Board has not considered this evidence.

alleges that he had previously established rights.

Applicant alleges that the artwork he developed was not derived from any Grateful Dead trademarks or works in which the band held any copyright.

Applicant's design, which featured a skeleton character whose uniform bore the name "Lithuania" dunking a basketball, was given worldwide exposure when the Lithuanian Olympic basketball team won the bronze medal by defeating the heavily-favored Russian team. The team from Lithuania wore the shirts which the Grateful Dead had commissioned and donated to the team, featuring applicant's design, on the victory podium as well as during the subsequent closing ceremonies of the Olympic games. Of record in connection with these appeals are excerpts from a number of published articles which indicate that the "slammin' skeleton" design which applicant had created caused nothing short of a sensation during and after the 1992 Olympics and the team, with the members wearing the shirts, was the subject of a great deal of publicity.

During that period, t-shirts bearing this design were sold in great numbers. While the original intent was for sales of the shirts to support the Lithuanian Olympic basketball team, an excess of funds was given to a charity which helped Lithuanian children. Applicant subsequently

obtained an injunction barring both the band and the Lithuanian basketball team's marketing arm from using applicant's design of a skeleton dunking a basketball with the name "Lithuania" in connection with their commercial activities.

The applications which are the subjects of these appeals seek registration of various forms of the original design and word combination, which applicant claims use of as his trademark in connection with the clothing products set forth in application SN. 75/646,864 since 1992, and the five other related marks, in six applications, which applicant asserts he has a bona fide intention to use in connection with the goods listed in the other applications. These marks, including the word mark "LITHUANIAN SLAM DUNKING SKELETON," are all thematically related to the original mark which is still in use by applicant. All appear to be attempts to profit from the notoriety given to the original design made famous when the Lithuanian team wore shirts bearing it at the 1992 Olympic Games.

The Examining Attorney contends that each of these marks, even the word-only mark, is unregistrable under Section 2(a) of the Act because each one falsely suggests a connection with the Lithuanian National Olympic Committee.

The test for registrability under Section 2(a) of the Act is well settled. Under this section of the Act, registration must be refused if the mark sought to be registered consists of matter which may falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols. As we have noted many times before, the language used in this portion of Section 2(a) does not spring from concern with problems caused by the use of similar trademarks on related goods. Section 2(d) of the Act deals with this situation. Instead, the language in Section 2(a) came into being out of concern for the rights of publicity and privacy. As our primary reviewing court stated in *The University of Notre Dame du Lac v. J. C. Gourmet Food Imports, Co., Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), the drafters of the statute were concerned with protecting the names of individuals and institutions which were not technical trademarks or trade names upon which objections under Section 2(d) the Act could be made. In *In re Cotter & Co.*, 228 USPQ 202 (TTAB 1985), this Board noted that "it is the Examining Attorney's burden to show that the mark sought to be registered is unmistakably associated with a particular 'persona.'" In order to do this, an Examining Attorney must show that the mark sought to be registered is the same

or a close approximation of the name or identity of a person, living or dead, or of an institution, and that it would be recognized as such. It must also be clear that the person or institution identified by the mark is not connected with the goods sold or the services performed by applicant under the mark. Finally, it must be shown that the fame or reputation of the named person or institution is of such a nature that a connection with such person or institution would be presumed when the applicant's mark is used on its goods or services."

Simply put, the Examining Attorney has not met his burden of establishing that the first element of this test is satisfied in any of the cases before us. A good deal of applicant's argument is misdirected, in the sense that it focuses on the ownership of copyrights, trademark rights and the question of whether applicant's marks are or will be likely to cause confusion in the marketplace. When we focus instead on the real issues presented by these refusals under Section 2(a) of the Act, however, we must conclude that this record does not demonstrate that any of the design marks presented in the drawings submitted with these applications or the word mark "LITHUANIAN SLAM DUNKING SKELETON" is the name or identity of the Lithuanian National Olympic Committee or the Lithuanian national

basketball team sponsored by the Lithuanian National Olympic Committee, or that any of the marks applicant seeks to register is even a close approximation of the name or identity of either of these institutions.

In support of his contention that "[t]he Lithuanian national basketball team is identified by the term LITHUANIA and basketball playing skeleton designs," (brief, p.5), the Examining Attorney made of record excerpts from a number of published articles. Contrary to his arguments, however, this evidence does not establish that the marks sought to be registered are the same as or a close approximation of the name or identity of either the Lithuanian National Olympic Committee or the basketball team which operates under its auspices. Instead, all that the evidence indicates is that in 1992, "... the Lithuanian athletes started a tiny fashion craze when they wore tie-dyed t-shirts with a skullman dunking a basketball." Wall Street Journal, July 22, 1996.

Nowhere in any of the articles submitted by the Examining Attorney is there any evidence which establishes that any of these trademarks is the same as, or a close approximation of, the name or identity of either the Lithuanian National Olympic Committee or its basketball team. That the team and its accomplishments were well

known and that it was well known that in 1992 they had worn clothing bearing the design featuring the skeleton dunking the ball with the word "LITHUANIA" is not disputed, but the Examining Attorney has not explained how these facts resulted in any of these marks becoming the name or identity of the team or the Olympic Committee which controlled it, nor has he explained how these facts could be understood to show that the marks applicant seeks to register are even a close approximation of such name or identity. Just because lots of people knew the team wore clothing bearing a substantially similar design and words does not make the design and words the team name or identity. Applicant is not seeking to register "LITHUANIAN NATIONAL BASKETBALL TEAM" or "LITHUANIAN NATIONAL OLYMPIC COMMITTEE" with the instant applications.

In summary, because the Examining Attorney has failed to meet the requirements for establishing that these marks falsely suggest a connection with the Lithuanian National Committee or the Lithuanian Olympic basketball team, the refusals to register based on Section 2(a) of the Act are reversed.